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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,851	10/04/2000	Robin E. Offord	GRFN-026/03US	1974

7590 03/13/2003

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EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

9

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.
09/678,851

Applicant(s)
Offord et al.

Examiner
Bennett Celsa

Art Unit
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-28 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 13 and 18-24, drawn to peptide compounds and compositions thereof, classified, for example, in class 530, subclass 300+.
 - II. Claims 9(in part) and 12, drawn to treating HIV virus using a RANTES peptide inhibitor, classified, for example, in class 424, subclass 184.1+.
 - III. Claims 9(in part) and 10-11, drawn to treating an inflammatory disease state, classified, for example, in class 514, subclass 824+.
 - IV. Claims 14-17 and 25-28, drawn to compounds and compositions comprising a peptide "organic chain" (e.g. polymer) conjugate, classified, for example, in class 525, subclass 54.1+.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as AZT or protease inhibitors and/or the product

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as claimed can be used in a materially different process of using that product such as immunoaffinity purification of the RANTES proteins or related proteins; for diagnostic use or for prospective use in treating inflammation.

4. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as use of bronchodilators and antihistamines and/or the product as claimed can be used in a materially different process of using that product such as immunoaffinity purification of the RANTES proteins or related proteins; for diagnostic use or for prospective use in treating HIV .

5. Inventions II and III are drawn to independent and/or patentably distinct and different methods of use (e.g. treating inflammatory disorders v. treating HIV) since they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects and are directed to the treatment of totally different disease states and/or disorders which address different pathologies, symptoms, mechanism of action and known treatment(s).

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6. Inventions I and IV are directed to independent and/or distinctly different compounds (e.g. peptide v. conjugate of a peptide) which possess different chemical structure, functions, physicochemical properties and are capable of separate manufacture and/or use and requires separate and divergent, burdensome manual and computer, structure and bibliographic searches.
7. Because these inventions are distinct for the reasons given above and
 - a. have acquired a separate status in the art as shown by their different classification;
 - b. require separate and divergent, burdensome manual and computer, structure and bibliographic searches; and/or
 - c. these inventions have acquired a separate status in the art because of their recognized divergent subject matter,restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES (*UPON SELECTION OF ANY OF GROUPS I-IV ABOVE*)

8. The claims (e.g. claims 1 and 9) are generic to a plurality of disclosed patentably distinct species (or use thereof) including:
 - A. R1-Rantes (2-68) or homologues: wherein R1 is defined in claim 1: and
 - B. The Grafting of one or more "organic chain-like molecules to the N and/or C terminus of R1-Rantes (2-68)

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BOTH A. And B. Encompass individual compound species having different compound structures and/or properties which are capable of separate manufacture and/or use which require separate and divergent, burdensome manual and computer, structure and bibliographic searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g. a single compound) within either group A. OR B. Above, by pointing to a compound present in the specification or indicating the value of ALL substituents defined by R1 (for R1-Rantes 2-68) (Groups I-III) AND upon election of Group IV, a specific organic chain-like molecule (E.g. Peg) AND its point of attachment to R1-Rantes (2-68), AND indicate claims readable thereon, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

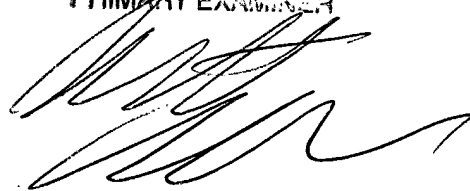
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)

March 12, 2003

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Bennett Celsa', written over the printed name and title.